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10/658,337	09/10/2003	Willard C. Wacha	19080.04	1868

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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,337

Applicant(s)

WACHA, WILLARD C.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-10, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11-13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20030910.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 2-10, 14, 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Election filed 3/29/2004.
2. Applicant's election with traverse of Species V in Paper filed 3/29/2004 is acknowledged. The traversal is on the ground(s) that "Applicant contends that he should be entitled to a consideration of a reasonable number of related embodiments falling within the scope of a generic inventive concept...". This is not found persuasive because each of the Species has a unique search that is not required in the search of the other Species. For instance, elected Species V requires a molded over area (200) not required for the search of the other Species. If applicant is traversing on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

3. The drawings are objected to because in Fig. 3 a fourth hook 110 (see spec. pg. 7, line 2) is not being shown. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the area between the first aperture and the second aperture is molded along a second hook provided at the second aperture (in Fig. 6 it appears that the molded over section 200 extends rearwardly from the second aperture 60 and along a hook 110; the area between 40 and 60 does not appear to be molded over; possibly the third aperture at the end of section 200 that is not labeled is what is intended by applicant---**changes must be made to the specification if such is the case**) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the area between the first aperture and the second aperture is provided with bait holders (possibly the third aperture at the end of section 200 that is not labeled is what is intended by applicant---

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**changes must be made to the specification if such is the case)** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The disclosure is objected to because of the following informalities:

Page 6, line 12, "28" should be changed to "24".

Page 6, line 16, "first aperture 40" should be changed to "second aperture 60".

Page 6, line 23, "second" should be deleted" (since Fig. 3 only shows a single hook).

Page 7, line 2, in the event that the objection to Fig. 3 is rectified by including hook (110), then "fourth" should be changed to "second".

Page 7, line 9, the phrase "is in the form of" should be changed to "has holds an".

Page 7, line 17, "second" should be deleted.

Page 7, line 19, "40" should be inserted after "first aperture" and "28" should be changed to "60".

Page 8, lines 6 and 8, "28" should be changed to "60".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 11, 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 11, the figures do not disclose that the area between the first and second aperture being molded over and along a hook. The molded over area 200 extends toward the rear from the second aperture. Possibly applicant is referring to the third aperture (that is not labeled) at the rear end of the molded over section 200 as the second aperture when in fact it should be disclosed as a third aperture.

In regard to claim 12, the figures do not disclose the area between the first and second aperture being provided with bait holders. The bait holders 75 are located rearwardly of the second aperture 60. Possibly applicant is referring to the aperture at the rear end of the molded over section as the second aperture when in fact it should be disclosed as a third aperture.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1, 11-13, 16, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the first and second apertures do not appear to be either on top portion or the bottom portion of the lip, instead it appears that these apertures extend through the lip.

In regard to claim 1, Species V (Fig. 6) does not have a plurality of spurs that can be wrapped around a third hook, instead it has bait holders (75). Also the bait holders (75) of Fig. 6 appear to be on the sides of the molded over section and not between the top (24) and bottom (26) portions of the lip.

In regard to claims 11 and 12, the term "the area between the first aperture and the second aperture" lacks antecedent basis.

In regard to claim 17, the phrase "the metal lip is replaced with a plastic lip" renders the claim vague and indefinite since it is reciting a method step when claim 17 is intended to be an apparatus claim and also because the preamble of the claim is "The **metal** lip jig rig".

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 11-13, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fagerholm 2,205,472.

Fagerholm discloses a metal lip (1) with a punched out strap (12), a first aperture (at 5 or at 25), a second aperture (where hook 3 exits adjacent 8), and bait holders (10, 11).

In regard to claims 11 and 12, Fagerholm discloses the area between the first and second apertures being molded (hook 3 extends through body) along a second hook (first hook not positively set forth previously therefore the only hook on Fagerholm can represent a second hook as claimed) and the area also having bait holders (portions of 10, 11 between apertures).

13. Claims 1, 11-13, 16, 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schlaegel 6,073,384.

Schlaegel discloses a metal lip (18 made of spring steel or plastic) with a punched out strap (12), a first aperture (40), a second aperture (40 or 32 at lower end in Fig. 3), and bait holders (16 or 30, 38 or 48).

In regard to claims 11 and 12, Schlaegel discloses the area between the first and second apertures (40 and 40 or 32 at the lower end) being molded (18 capable of being made of plastic; the molded structure is not being particularly claimed) along a second hook (area between apertures extends **along** the same axis as the hook; first hook not positively set forth previously therefore the only hook on Schlaegel can represent a



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second hook as claimed) and the area also having bait holders (tips 30, 38 are capable of holding bait).

14. Claims 1, 11-13, 16, 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marshall 5,077,931.

Marshall discloses a metal lip (12) with a punched out strap (between 22 & 23 which is capable of receiving line), a first aperture (24), a second aperture (26), and bait holders (50, 52, 54 are capable of holding bait and are between top and bottom portions since it extends through 22, 23).

In regard to claims 11 and 12, Marshall discloses the area between the first and second apertures (40 and 40 or 32 at the lower end) being molded (12 extends along the hook 30; the molded structure is not being particularly claimed) along a second hook (area between apertures 24, 26 extends **along** the same axis as the hook; first hook not positively set forth previously therefore the only hook on Schlaegel can represent a second hook as claimed) and the area also having bait holders (outer lateral sides of 12 are capable of holding bait).

15. Claims 1, 12, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Perry 2,538,703.

Perry discloses a metal lip (10 of sheet metal) with a punched out strap (25-27), a first aperture (23 or 17), a second aperture (19), and bait holders (18).

In regard to claim 12, Perry discloses a bait holder (channel of 10 defined by 16).

16. Claims 1, 12, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bayer 4,126,956.

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Bayer discloses a metal lip (1 of stainless steel) with a punched out strap (hole 8 punched out of 2), a first aperture (6), a second aperture (5), and bait holders (11,12).

In regard to claim 12, Perry discloses a bait holder (channel of 10 defined by 16).

17. Claims 1, 12, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kurtis 3,284,945.

Kurtis discloses a metal lip (11 of metal) with a punched out strap (12), a first aperture (15), a second aperture (17), and bait holders (25, 27).

In regard to claim 12, Kurtis discloses a bait holder (part of 12).

18. Claims 1, 12, 13, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sisco 2,254,981.

Sisco discloses a metal lip (10) with a punched out strap (7), a first aperture (6, 8, or 21), a second aperture (13 or 14), and bait holders (10).

In regard to claim 12, Sisco discloses a bait holder (10 capable of holding bait).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlaegel 6,073,384 in view of Hedman 4,367,607.

Schlaegel does not disclose the area between the first and second apertures being molded along a hook. Hedman discloses an area between apertures (first aperture represented by portion of 14 through which 22, 72 extend and second aperture represented by portion through which 12 emerges from 14) being molded along a hook (12). It would have been obvious to a person of ordinary skill in the art to mold the lip of Schlaegel such that the area between the first and second apertures is molded along a hook in view of Hedman in order to positively secure the hook to the lip.

21. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931 in view of Hedman 4,367,607 or Frevert 2,019,959.

Marshall does not disclose the area between the first and second apertures being molded along a hook. Hedman and Frevert disclose an area between apertures (first aperture represented by portion of 14 through which 22, 72 extend and second aperture represented by portion through which 12 emerges from 14 AND between 5 and 9) being molded along a hook (12 AND 11, 10). It would have been obvious to a person of ordinary skill in the art to mold the lip of Marshall such that the area between the first

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and second apertures is molded along a hook in view of Hedman in order to positively secure the hook to the lip.

22. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall 5,077,931.

Marshall discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

23. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perry 2,538,703.

Perry discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

24. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer 4,126,956.

Bayer discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

25. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtis 3,284,945.

Kurtis discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

26. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sisco 2,254,981.

Sisco discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

27. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fagerholm 2,205,472.

Fagerholm discloses the lip made of metal but not of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of plastic, since it has been held to be within the general skill of a

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worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

28. Claims 1, 11-13, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karisch 3,187,457 in view of Orlik 2,900,754.

Karisch discloses a metal lip (100) with a punched out strap (110 is punched out of 104), a first aperture (108), a second aperture (where hook 106, 107 exits adjacent 102), but does not disclose spurs/bait holders. Orlik discloses lip (22) with spurs/bait holders (20) between apertures (5 & 8). It would have been obvious to a person of ordinary skill in the art to employ the spurs/bait holders of Orlik in the lure of Karisch in order to provide means for attaching further attracting means to the lure.

In regard to claims 16 and 17, Karisch and Orlik disclose the lip made of metal but not of a non-toxic metal or plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the lip out of non-toxic metal or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because a non-toxic metal will not pollute the water and plastic can be readily formed into different configurations, sizes, and colors. *In re Leshin*, 125 USPQ 416.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA